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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,919	10/15/2003	William E. Welnick	33692.03.3198	7060
23418	7590	11/23/2009		
VEDDER PRICE P.C. 222 N. LASALLE STREET CHICAGO, IL 60601			EXAMINER KAMPURIA, SHARAD K	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 11/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/685,919

**Applicant(s)**

WELNICK ET AL.

**Examiner**

SHARAD RAMPURIA

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102 (b) as being anticipated by **Hooper; Jeff Duwayne et al.** [US 5734980 A].

As per claim 1, **Hooper** teaches:

A circuit ( in view of the steps of Figure 2) operative to acquire a more-preferred stored system identification (SID) element comprising: memory (column 6, lines 41 to 65) containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 52 to 54) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (column 6, lines 54 to 65, the more-preferred and less-preferred SID elements are being interpreted to be any SID element that is ranked above Or below respectively one another); and logic circuitry, operatively coupled to the memory, and operative to perform a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the at least one more-preferred stored SID

element using a same frequency during the second more-preferred SID acquisition sequence.

(e.g. A service provider may have initially obtained a license to provide cellular service in a single geographical area but may have not had the financial resources to obtain cellular licenses in other geographical areas. Later, even with sufficient financial resources, the service provider may still have been shut out of other geographical areas due to a dwindling supply of available cellular licenses. However, acquisition of newly available PCS licenses will allow the service provider to enter additional geographical areas. For example, a single service provider may operate the cellular system 118 in Seattle, the PCS system 136 in Houston, the PCS system 154 in Chicago and the PCS system 170 in New York or have a unique roaming agreement with those systems. A subscriber enrolling with the service provider in Seattle will have the cellular system 118 designated as the home system for the mobile terminal. Previously, if the subscriber roamed to Houston, Chicago and New York, their mobile terminal would select the cellular systems 132, 146 and 160 in each of these cities. However, in accordance with the teachings of the present invention, **by storing a list of preferred systems in the memory of the mobile terminal which ranks the commonly owned systems (the PCS systems 136, 154 and 172) higher than systems owned by others, for example, by ranking the PCS systems 136, 154 and 172 first, second and third, the subscriber's mobile terminal will select systems owned by the service provider over systems owned by others;** Col.12; 31-Col.13; 15).

Hooper also discloses all the elements of claims 2, 7, and 11, including wherein the logic circuitry is operative to attempt acquisition of the at least one less-preferred stored SID element

as part of performing the second more-preferred SID acquisition sequence. See, column 9, lines 12 to 28 and Figure 2.

Hooper also discloses all the elements/steps of claims 3, 12, and 17, including wherein the logic circuitry is operative to perform the second more-preferred SID acquisition sequence if the more-preferred stored SID element is not acquired during the first more-preferred SID acquisition sequence. See, column 10, line 65 to column 11, line 13 and Figure 2.

Hooper also discloses all the elements of claim 4, including, wherein the logic circuitry is operative to attempt acquisition by comparing received broadcast SID information with one of the plurality of stored SID elements ranked according to an order of preference including at least one more-preferred stored SID element and at least one less-preferred stored SID element. See, column 9, lines 1 to 11 and claim 1.

Hooper also discloses all the elements of claims 5 and 13, including wherein the roaming list includes a (storing) first more-preferred stored SID element, (storing) a second more-preferred stored SID element, and a plurality of less preferred SID elements wherein logic circuitry is operative to perform the second more-preferred SID acquisition sequence, that includes repeatedly attempting acquisition of the first more-preferred stored SID element, repeatedly attempting acquisition of the second more-preferred stored SID element and a single acquisition attempt of each of the at least one less-preferred stored SID element. See column 9, line 46 to column 10, line 65 and Figure 2, for example, if two frequencies are searched and the second

frequency is determined and stored at step 92 and there are no further frequencies to search then repeated acquisition of a first and a second more-preferred SID have been done at steps 86 and 90 and single attempted acquisitions have been attempted in step 94 for the other stored SIDs for the first frequency scanned.

Hooper also discloses all the elements of claim 9, including the logic circuitry camps on at least one less-preferred stored SID element if acquisition on the at least one less-preferred stored SID element is available (column 10, lines 47 to 64) and if acquisition on the at least one more-preferred store SID element is unavailable (Id.), and wherein the logic circuitry camps on the at least one more-preferred SID stored element if the at least one more-preferred stored SID element is acquired at any time (column 10, line 65 to column 11 line 13).

Hooper discloses all the steps of claim 15, including, receiving broadcast SID information, wherein attempting acquisition is based on comparing the received broadcast SID information with one of the Plurality of stored SID elements. See, column 9, lines 1 to 11.

Hooper also discloses all the steps of claim 18, including attempting acquisition of the at least one less-preferred stored SID element as part of performing the second more-preferred SID acquisition sequence. See, column 9, lines 12 to 28.

Hooper also discloses all the elements of claim 20, including camping on the at least one more-preferred stored SID element if acquisition of the at least one more-preferred stored SID element is available (column 9, lines 1 to 11); and camping on the at least one less-preferred stored SID

element if acquisition of the at least one less-preferred stored SID element is available and if acquisition of the at least one more-preferred stored SID element is unavailable (column 10, lines 47 to 64).

Hooper also discloses all the elements of claim 16. See the rejection of claims 9 and 20.

Hooper also discloses all the elements of dependent claim 21, including wherein the more-preferred stored SID element defines the home system. See, step 78. of Fig.2.

*Claims 6, 8, 10, 14, 19, are* the wireless device, memory containing instructions executable by one or more processing devices, method claims, corresponding to the logic circuitry claim 1 respectively, and rejected under the same rational set forth in connection with the rejection of claim 1 respectively, above.

#### ***Response to Amendments & Remarks***

Applicant's arguments with respect to claims 1-21, have been fully considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870. The examiner can normally be reached on M-F. (8:30-5 EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharad Rampuria/  
Primary Examiner  
Art Unit 2617